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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,895	10/18/2002	Eckart Karl Heinz Voss	9424.170US01	2379
23552	7590	09/15/2004	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			BERKO, RETFORD O	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/049,895	Applicant(s) VOSS ET AL.	
	Examiner Retford Berko	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/18/02</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Acknowledgement: The Information Disclosure Statement and Preliminary Amendment filed October 18, 2002 is acknowledged.

Status of Claims

Claims 1-17 are pending in the application; only claims 3-9 are amended.

Oath and Declaration

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c). Inventors Knebel, S. and Withell, T. made non-initialed, non-dated alterations in the oath and a new oath/declaration is required.

Claim Rejections-35 USC Sec 112

Claims 16-17 provide for the use of cosmetic compositions in the form of sun cream, shampoo, deodorant, lotion etc comprising a thickener, propellant, surfactant and water in a container under pressure but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 16-17 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-3 and 5-15 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Lisboa et al (US 5, 679, 324) in view of Monson et al (WO 97/20626) further in view of Clark et al (US 4, 753, 747).

The claims are directed toward a cosmetic composition a thickner, isopentane as propellant, surfactant and water; said composition in a plastic container under pressure of at least 0.1 bar in excess of atmospheric pressure and below 3.0 bar (or not more than 2.0 bar). The claims are also drawn toward the composition wherein the thickner is 0.01-30% wt/%, the propellant is 1-15 wt% and the composition contains surfactant (0.5-50%) the balance being water and body care ingredients. The claims are further drawn toward the composition wherein the thickner is a gum (xanthan gum, guar-guar) or polymer such as polymethacrylate; that the composition comprises emulsifiers, fatty alcohol and fatty alcoholalkoxylate $R_2O(AlkO)_m$; the

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composition is a gel having viscosity of the composition is 10, 000 to 50, 000 (preferably 20,000-30,000 mps).

Lisboa et al (Patent '324) discloses aerosol, foamable fragrance-based composition for moisturizing the skin, said composition comprising a surfactant, propellant, thickner and cosmetically active ingredients as in the instant claims (abstract, col 1, lin 60-65; col 2, lin 5-60 and col9, lin 50-65 continuing to col 10, lin 1-45).

Patent WO '626 does not disclose isopentane as propellant, does not disclose a container for the composition and does not indicate whether the composition is in gel form.

Monson et al (WO '626) disclose a cosmetic composition under dispensing pressure (page 10, lin 10-15 and page 13, lin 15-20) in a container having a plastic barrier (page 11, lin 21-30); said composition comprising the ingredients as in the instant claims and also disclose the use of at least one surfactant (page 8, lin 5-10 and page 16, lin 1-50). More significantly, Patent WO '626 discloses the use of isopentane as propellant (page 9, lin 20-25 and pages 16-17).

Patent WO '626 does not disclose a gel formulation.

Clark et al (Patent '747) discloses a process for making soap-containing cosmetic products such as cream in aerosol or post foaming gel form. Patent '747 discloses the use of gum, glyceryl isostearate admixed with aqueous fatty acid to form a dispersion; discloses the relative amounts of ingredients and discloses the use of isopentane as propellant—the composition is under pressure of about 80 psi (example 9 at col 13).

One of ordinary skill in the art would be motivated to prepare a cosmetic propellant composition by using the ingredients as disclosed in the prior art cited. One of ordinary skill would expect reasonable level of success in obtaining a stable and homogeneous mixture in a

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dispersion formulation wherein the dispersion is readily pumpable and easily filled into aerosol, dual compartment, dispensing containers in liquid form, with gel formation taking place within the container (Patent '747, lin 10-20). More importantly, one of ordinary skill would have a motivation to combine the methods in the prior art cited because one of ordinary skill would expect to take advantage of the characteristics of the process disclosed wherein the process can be carried out in the presence of the ingredients normally found in personal care products such as shampoo, hair grooming and shave cream compositions (Patent '747, col 5, lin 18-25).

Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill at the time it was made.

2. Claims 1-5 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Monson et al (WO 97/20626) in view of Clark et al (US 4, 753, 747) further in view of Martino et al (US 5, 288, 493).

The claims are directed toward a cosmetic composition a thickner, isopentane as propellant, surfactant and water; said composition in a plastic container under pressure of at least 0.1 bar in excess of atmospheric pressure and below 3.0 bar (or not more than 2.0 bar). The claims are further directed toward the composition wherein the ingredients comprise of two surfactant and hydrophobic compound having HLB-value (i.e. hydrophobic-lipophilic balance) of less than 10 and a viscosity of 5, 000-50, 0000.

The disclosures in Monson et al (Patent WO '626) and Clark et al (Patent '747) have been discussed above; both patents meeting the limitations in applicant's instant claims.

Neither Patent WO '626 nor Patent '747 disclose HLB-values.

Martino et al (Patent '493) disclose skin care compositions having improved rub-off resistance characteristics (abstract, col 1, lin 60-65); said composition in the form of emulsion (col 2, lin 57-65 and col9, lin 45-60). According to Martino et al, the composition comprises of water-in-oil emulsion and characterized by ingredients having HLB values of less than 10 (col 3, lin 10-30) and may include a propellant (col 4, lin 40-50) and has an improvement in the rub-off resistance as a result of adding amounts of copolymers consisting of C1-C18 alkyl acrylate or methacrylate, acrylamide and unsaturated carboxylic acids (col 9, lin 50-65).

One of ordinary skill in the art would be motivated to prepare a cosmetic propellant composition by using the ingredients as disclosed in the prior art cited. One of ordinary skill would expect reasonable level of success in obtaining a stable and homogeneous mixture in a dispersion formulation wherein the dispersion is readily pumpable and easily filled into aerosol, dual compartment, dispensing containers in liquid form, with gel formation taking place within the container (Patent '747, lin 10-20). The motivation to combine the methods cited in the prior art lies in the reasonable expectation to obtain a product with improved rub-off resistance which is a desirable quality for consumers. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill at the time it was made.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Retford Berko** whose telephone number is 571-272-0590. The examiner can normally be reached on M-F from 8.00 am to 5.30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Thurman K Page**, can be reached on 571-272-0602.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
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